

REMARKS

Applicant acknowledges receipt of the Office Action mailed November 14, 2006.

In the Office Action, the Examiner objected to claims 51-57 under 37 C.F.R. § 1.75(c); rejected claims 50-57 under 35 U.S.C. § 112, second paragraph; rejected claims 36, 37, 42, 43, 44-46, and 49-57 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over JP 10-217257 (JP '257); rejected claim 44 under 35 U.S.C. § 103(a) as being unpatentable over JP '257 in view of *Inoue et al.* (U.S. Patent No. 6,521,058); rejected claims 36, 44, and 45 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,766,999; and provisionally rejected claims 36-57 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 36, 38-48, 50, and 51 of copending U.S. Patent Application No. 11/364,211.

In this Amendment, Applicant amends claims 36, 39, 40, 46, and 47, and cancels claims 38 and 50-57, without prejudice or disclaimer. Claims 1-35 were previously canceled in the Preliminary Amendment filed April 20, 2004. Upon entry of this Amendment, claims 36, 37, and 39-49 will remain pending. Of these claims, claims 36, 40, 46, and 47 are independent.

The originally-filed specification, claims, abstract, and drawings fully support the amendments to claims 36, 39, 40, 46, and 47. No new matter has been introduced.

Based on the foregoing amendments, Applicant traverses the objection and rejections above and respectfully requests reconsideration for at least the reasons that follow.

I. OBJECTION TO THE CLAIMS

Claims 51-57 stand objected to under 37 C.F.R. § 1.75(c). Applicant submits that the objection to the claims has been rendered moot by the cancellation of claims 51-57. Applicant therefore requests that the objection to the claims be withdrawn.

II. 35 U.S.C. § 112, SECOND PARAGRAPH REJECTION

Claims 50-57 stand rejected under 35 U.S.C. § 112, second paragraph. Applicant submits that the rejection of claims 50-57 has been rendered moot by the cancellation of claims 50-57. Applicant therefore requests that the rejection of claims 50-57 under 35 U.S.C. § 112, second paragraph, be withdrawn.

III. 35 U.S.C. § 102(b) / § 103(a) REJECTION

Applicant traverses the rejection of claims 36, 37, 42, 43, 44-46, and 49-57 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over *JP '257*. Applicant respectfully submits that amended independent claims 36 and 46 patentably distinguish over *JP '257* at least for the reasons described below. Applicant further submits that the rejection of claims 50-57 has been rendered moot by the cancellation of those claims.

In order to properly establish that *JP '257* anticipates Applicant's claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Further, in order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of the three requirements must "be found in the prior art, and not be based on applicant's disclosure." See M.P.E.P. §2143, 8th ed., February 2003.

With respect to independent claim 36, Applicant has amended claim 36 to include the limitation of dependent claim 38, namely, "wherein the forming step includes grinding the part of the die base body to form the die face," which the Examiner admits is not disclosed in *JP '257* (emphasis added). Accordingly, since *JP '257* fails to disclose each and every element of independent claim 36, *JP '257* fails to anticipate claim 36, and claims 37 and 42-45 that depend from claim 36. Therefore, claims 36, 37, and 42-45 are patentable over *JP '257*.

With respect to independent claim 46, *JP '257* appears to disclose a method of manufacturing a mold wherein a part of a cavity portion or the whole cavity portion is made of amorphous alloy having a supercooled liquid region. (*JP '257*, Abstract).

JP '257, however, does not disclose forming a die face onto a part of the die base body, wherein the forming step includes coating a resist on the die base body, removing a part of the coated resist by exposing the resist to an electronic beam or a

laser beam, and developing a pattern by exposing the die base body to an ion shower
to form the die face, as required by claim 46 (emphases added).

Accordingly, with respect to independent claim 46, *JP '257* fails to teach
Applicant's claimed combination, including, *inter alia*:

"forming a die face onto a part of the die base
body,...wherein the forming step includes coating a resist on
the die base body, removing a part of the coated resist by
exposing the resist to an electronic beam or a laser beam,
and developing a pattern by exposing the die base body to
an ion shower to form the die face" (emphases added).

Since *JP '257* fails to disclose each and every element of independent claim 46,
JP '257 fails to anticipate claim 46, and claim 49 that depends from claim 46.
Therefore, claims 46 and 49 are patentable over *JP '257*.

IV. 35 U.S.C. § 103(a) REJECTION

Applicant respectfully traverses the Examiner's rejection of claim 44 under 35
U.S.C. § 103(a) as being unpatentable over *JP '257* in view of *Inoue*. The shortcomings
of *JP '257* are discussed above.

With respect to *Inoue*, the Examiner alleges that *Inoue* teaches that "adding
palladium to the composition of an alloy, strengthens it..." (*Office Action*, p. 4, ll. 14-15).
Such teaching, even if present in *Inoue*, however, fails to teach or suggest Applicant's
claimed method of producing a molding die for molding an optical element, including,
inter alia, "forming a die face onto a part of the die base body...wherein the forming step
includes grinding the part of the die base body to form the die face" (emphasis added).
Thus, *Inoue* also fails to overcome the above noted shortcomings of *JP '257*, and claim
44 is allowable at least due to its dependence from independent claim 36.

V. DOUBLE PATENTING REJECTIONS

Claims 36, 44, and 45 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,766,999; and claims 36-57 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 36, 38-48, 50, and 51 of copending U.S. Patent Application No. 11/364,211. Although Applicant respectfully disagrees the Examiner's rejections, in an effort to advance prosecution of this application, Applicant has filed a Terminal Disclaimer, with respect to U.S. Patent No. 6,766,999 and U.S. Patent Application No. 11/364,211, concurrently with this Amendment. Accordingly, Applicant respectfully submits that the Examiner's double patenting rejections are moot and the rejection of claims 36-57 should be withdrawn.

VI. CONCLUSION

Applicant respectfully submits that claims 36, 37, and 39-49 are in condition for allowance.

The Office Action contains characterizations of the claims and the related art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: May 14, 2007

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Attachment: Terminal Disclaimer